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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,137	05/06/2004	Neil R. Wilson	H 50052 HST	7260

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HENKEL CORPORATION
THE TRIAD, SUITE 200
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EXAMINER

CARRILLO, BIBI SHARIDAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/840,137

Applicant(s)

WILSON ET AL.

Examiner

Sharidan Carrillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/6/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/6/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is unclear what would be considered as an effective temperature to remove paint. Claim 2 is indefinite since the functional group of alkyl ammonium or alkanol ammonium is not recited as part of the markush group. Claim 3 is indefinite because it is unclear what is meant by acid equivalent weight. Claim 13 is indefinite because it is not clear what is meant by "number average molecular weight".

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-5, 7, 10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bergishagen et al. (5443748).

Bergishagen et al. teaches a method of cleaning paint covered surfaces of paint line tubes, paint line fixtures, and paint booths during a cleaning cycle using a composition comprising a polymeric material and an organic solvents (Abstract, col. 3,

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lines 35-43. Bergishagen et al. teach polymers including polyacrylamide, ethylene oxide polymers, and polyacrylic acid. The claim limitation of less than 5 weight percent water reads on no water present. In col. 4, lines 1-17, Bergishagen et al teaches the solvent carrier can be an organic solvent. In reference to claims 3 and 13, the limitations are inherent properties of the composition. In reference to claim 4, refer to col. 4, lines 1-17. In reference to claim 5, refer to col. 3, lines 58-60. In reference to claim 7, refer to col. 4, lines 53-57. In reference to claim 10, Bergishagen et al teaches a polyacrylic acid.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergishagen et al. (5443748).

Bergishagen et al. fail to teach the specific concentration of each of the organic solvent. In the absence of a showing of criticality, adjusting the concentration would have been within the level of the skilled artisan (Akzo v. E. I. DuPont de Nemours 1 USPQ 2d 1704 Fed.Cir. 1987). Bergishagen et al. is silent with respect to the type of paint removed. However, it would have been within the level of the skilled artisan to remove epoxy, polyurethane, or polyacrylamide resins since these paints are conventionally used in paint spray booths (4948513).

9. Claims 2, 11-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergishagen et al. (5443748) in view of Waldmann et al. (5294352).

Bergishagen et al. teach the invention substantially as claimed with the exception of the polymer having functional groups made of ammonium salts, phosphoric acids, amines, and a combination of an acid and an amine group.

Waldmann teaches a composition for detackification and removal of paint from paint spray booths. In col. 6 and 7 bridging and col. 9, Waldmann teaches polymer

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adduct compositions comprising functional groups of phosphoric acid (component A) and polyalkylamine (component b) and a tertiary ammonium salt group (component D).

It would have been obvious to a person of ordinary skill in the art to have modified the method of Bergishagen et al. to include polymers having various functional groups, as taught by Waldmann, for purposes of performing the same function of paint removal.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Huang et al. teach a composition of paint detackification. Mitchell teaches controlling paint overspray. Dixon et al. teach a cleaning composition. Purnell et al. teach a paint spray booth treatment. Harbin teaches a non-abrasive cleaning composition. Beleck teaches a method of paint removal. Foster teaches a method of treating paint booth systems. Coleman et al. teach detackifying paint. Geke et al. teach treating circulating water in paint booths.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharidan Carrillo
Primary Examiner
Art Unit 1746

bsc



SHARIDAN CARRILLO
PRIMARY EXAMINER